



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/825,399	04/03/2001	Kevin X. Chen	IN01154K	1622

24265 7590 12/15/2003  
SCHERING-PLOUGH CORPORATION  
PATENT DEPARTMENT (K-6-1, 1990)  
2000 GALLOPING HILL ROAD  
KENILWORTH, NJ 07033-0530

EXAMINER

MONDESI, ROBERT B

ART UNIT	PAPER NUMBER
----------	--------------

1653

DATE MAILED: 12/15/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/825,399

Applicant(s)

CHEN ET AL.

Examiner

Robert B Mondesi

Art Unit

1653

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on 05 December 2003.
- 2a) ☒ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-25,27 and 31-36 is/are pending in the application.
- 4a) Of the above claim(s) 28 and 30 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,31 and 32 is/are rejected.
- 7) ☒ Claim(s) 3-25,27 and 33-36 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Response to Amendment*

This Office Action is in response to amendment filed September 22, 2003. The applicant has canceled claims **26 and 29**. **Claims 28-30** are withdrawn from further consideration. **Claims 1-4, 6, 8-10, 12 and 34** have been amended. **Claims 1-25, 27 and 31-36** are pending and currently under examination.

Amendment to the specification filed September 22, 2003 has been received and considered. Priority to provisional application 60/194,607 filed April 5, 2000 has been granted.

### *Withdrawal of Objections and Rejections*

The rejection of the **Claims 1-4, 6, 8-10 and 12** under 35 U.S.C. 112, second paragraph, is withdrawn.

The rejection of **claims 26 and 29** under 35 U.S.C 101 is withdrawn.

### *Claim Rejections - 35 USC § 112*

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

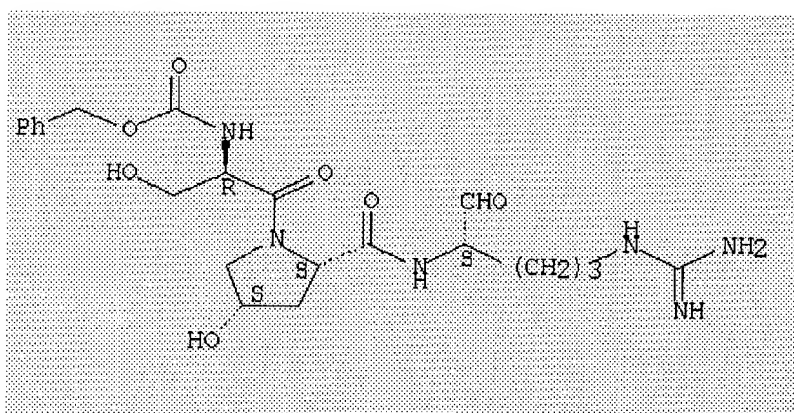
**Claims 31-32** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In **claims 31-32**, "HCV" (Hepatitis C Virus) needs be spelled out in the first instance of use.

***Claim Rejections - 35 USC § 102***

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**Claims 1 and 2** are rejected under 35 U.S.C. 102(b) as being anticipated by Brunk et al. WO 00/05245. Brunk et al. teach, (pages 33, line 12, to page 43 line 7, and claim 1, pages 159-167), the following structure;



**Claim 1** recites a structure according to the compound Formula I, with the following limitations; J may be (CH<sub>2</sub>), G may be (CH<sub>2</sub>), L may be CH, E may be CH, Q and M may be absent and when Q and M are absent A is directly linked to L, A may be O, R<sub>1</sub> may be COR<sub>5</sub> and R<sub>5</sub> may be OH, R<sub>2</sub> may be an amino, R<sub>3</sub> may be an C<sub>1</sub>-C<sub>10</sub> alkyl where said alkyl is optionally substituted with a hydroxy, Z may be N, R<sub>4</sub> maybe H, W may be C=O and Y may be an alkoxy. **Claim 2** is a further limitation of **claim 1** that states R<sub>1</sub> may be COR<sub>5</sub> and R<sub>5</sub> may be OH. Thus Brunk et al. teach all the elements of **claims 1 and 2** and these claims are anticipated under 35 USC 102(b).

### ***Conclusion***

**Claims 1-2** are rejected and are not allowed.

**Claims 3-25, 27 and 33-36** are objected to as being dependent upon a rejected base claim.

**Claim 31** would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action.

**Claim 32** would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

### ***Response to Comments***

The new rejections of this office action are in response to the applicants' amendment filed September 22, 2003. **Claims 1 and 2** are no longer indefinite therefore the examiner was able to search the claims. In most cases the examiner is able to search claims that are rejected under 35 U.S.C 112, second paragraph, but in the instant case due to the nature of the general formula and the given multitude of possible substitutions it would have not been possible to search the given structures using available search methods.

Furthermore, the examiner did not request an election of species as the applicant has stated in the remarks section of amendment filed September 22, 2003. However the examiner did request a further election of a core structure for the purpose of a search.

Claims 28-30 are drawn to a method of treatment and are in Group II. Claim 1 is drawn to a composition and is in Group I. Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case : product can be used in the alternative processes of apoptosis of cells. Therefore restriction is proper and made final. However, where applicant elects claims directed to the product, and a product claim is subsequently found allowable, withdrawn process claims that depend from or otherwise include all the limitations of the allowable product claim will be rejoined in accordance with the provisions of MPEP § 821.04.

**Process claims that depend from or otherwise include all the limitations of the patentable product** will be entered as a matter of right if the amendment is presented prior to final rejection or allowance, whichever is earlier. Amendments submitted after final rejection are governed by 37 CFR 1.116; amendments submitted after allowance are governed by 37 CFR 1.312.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103, and 112. Until an elected product claim is found allowable, an otherwise proper restriction requirement between product claims

and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowed product claim will not be rejoined. See "Guidance on Treatment of Product and Process Claims in light of *In re Ochiai*, *In re Brouwer* and 35 U.S.C. § 103(b)," 1184 O.G. 86 (March 26, 1996). Additionally, in order to retain the right to rejoinder in accordance with the above policy, Applicant is advised that the process claims should be amended during prosecution either to maintain dependency on the product claims or to otherwise include the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.**

Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert B Mondesi whose telephone number is 703-305-4445. The examiner can normally be reached on 9am-5pm, Monday- Friday.

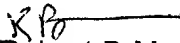
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Low can be reached on 703-308-2923. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0198.

Application/Control Number: 09/825,399

Page 7

Art Unit: 1653

  
Robert B Mondesi  
Patent Examiner  
Group 1653

12-09-03



ROBERT A. WAX  
PRIMARY EXAMINER